Applicants Response to Examiner's Comments

Examiner notes that an amendment to the claims 1, 6-8, 10, 14, 17-18, 21-22 and 24-26 has been entered and made of record in the application of Lane et al. for a "secure personal RFID documents and method of use" filed December 09, 2003. Examiner further notes that claims 1-26 are pending.

In the Drawings

Applicant appreciates Examiner's notation that the replacement drawing(s) received on November 7, 2006, and that these drawing(s) are accepted.

Examiner's Response to Applicant's Arguments of November 7, 2006

Examiner states that applicant's arguments with respect to claims 7 and 10-26, filed November 2006 have been fully considered but are moot in view of the new ground(s) of rejection.

Examiner further states that in response to Applicant's argument that currently amended Claims 1-6 includes and is limited too, allowable subject matter and teaches that "a change in information stored in the durable memory of the secure document may result in an automatic update of information stored in a plurality of related electronic documents by means of a communication networks" does not include certain features of Applicant's invention, the limitations on which the Applicant argues and relies above are not stated in these claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated on unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

Applicant responds that Claims 1 and 4 as currently amended are now dependent from Claim 8, and that Claims 2, 3, 5 and 6 are cancelled in the interests of an expeditious prosecution and without prejudice, that Examiner's arguments above are therefore moot.

Claim Objections

Examiner states that there is insufficient antecedent basis for the limitation in Claim 8, line 11, which recites the limitation, "the group." Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner objects to Claim 8 because of the following informalities: "the group" in line 16 should be "another group". The examiner states that an appropriate correction is required. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner objects to Claim 8 because of the following informalities: "a primary/secondary document coupled with the first electronic memory" in lines 8 and 19 should be "a primary/secondary document includes the first electronic memory" because the memory embedded within the document, see Specification on page 39. Examiner states that an appropriate correction is required. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner states that there is insufficient antecedent basis for the claim made in Claim 8, which recites the limitation "the second electronic memory" in lines 19 and 20. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner objects to Claim 8 because of the following informalities: "whereby a change in information related to the primary or secondary document" in line 22 should be "whereby a change in information stored in the memory related to the primary of secondary document. Examiner states that an appropriate correction is required. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner states that there is insufficient antecedent basis for the limitation in Claim 14, which recites the limitation "the group" in line 13. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner objects to Claim 14 because of the following informalities: "human being," in line 19 should be "human being;". Examiner states that an appropriate correction is required. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner states that there is insufficient antecedent basis for the limitation in Claim 18, which recites the limitation "the group" in line 21. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Examiner objects to Claim 18 because of the following informalities: "human being," in line 7 should be "human being;". Examiner states that an appropriate correction is required. Applicant replies that Claim 8 as currently amended herein corrects this defect.

Claim Rejections – 35 USC § 103

Examiner rejects Claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over Yap et al. (US# 6,111,506) in view of Hopkins (US# 5,757,918).

Examiner states that, referring to Claim 1, Yap et a;. disclose a secure document (10) (i.e. a security identification document) communicatively coupled and associated with a plurality of related electronic documents (i.e. luggage identification document a travel authorization document) by an electronic communication network (64) (i.e. a computer) (column 1 lines 23 to 30; see Figure 7), the secure document (10) (i.e. a security identification document) containing: a flexible substrate (12) having a surface (column 12 line 28 to 39; see Figures 1 to 5), the surface visibly presenting information (column 14 lines 17 to 21); and

An integrated circuit (14) (i.e. a microprocessor) coupled with the substrate (12), the integrated circuit (14) including: a durable memory (i.e. embedded in microprocessor 14), the durable memory storing a 1st digital code (i.e. secure identification data), wherein the 1st digital code is related to a life factor (i.e. birth certificate data, driver's license data information) (column 5 lines 45 to column 6 lines 33; column 12 lines 42 to 58; see Figures 1 and 7), and whereby certification for the authentication and/or accuracy of the secure document (10) is based at least partly on the 1st digital code (identification data) stored within the integrated circuit (14) (column 7 line 12 to 67; column 8 line 40 to 65; column 14 line 53 to column 16 line 54; see figures 1 to 8),

Wherein modification to information stored in the durable memory of the secure document (10) may be read by the electronic communications network (64) (i.e. a computer) (column 15 lines 6 to 37; see Figure 7) and employed to modify at least one of the plurality of related electronic documents (i.e. luggage identification document or a travel authorization document (column 16 lines 39 to 54).

Examiner further states that, however, Yap et al. did not explicitly disclose a 2nd digital code and the 2nd digital code is a n encryption code.

Examiner further states that, in the same field of endeavor of an identification transponder, Hopkins teaches that a 2nd digital code (aB) (i.e. a secret value) and the 2nd digital code is a n encryption code (column 5 lines 56 to 64; see Figures 1 to 5) in order to secure the smart card reading terminal and the host computer and to avoid counterfeit card.

Examiner further states that, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize the secret value (aB0 in smart card taught by Hopkins in an improved security identification document of Yap et al. because the secret value is

not transmit to the reading terminal would avoid duplication or counterfeit of the identification of the smart card.

Applicant replies that Claim 1 as currently amended is dependent from the allowable Claim 8 and is therefore allowable.

In reference to Claim 2, examiner states that Yap et al in view of Hopkins disclose the system and secure document of claim 1, Yap et al, disclose wherein the life factor is related to an event of a specific human being, the event selected from the group consisting of a birth of a human being (column 4 line 2 to 24; column 14 line 8 to 37).

Applicant replies that Claim 2 is cancelled without prejudice and in the interest of an expeditious prosecution.

In reference to Claim 3, examiner states that Yap et al. in view of Hopkins disclose the system and the secure document of claim 1, Yap et al. disclose wherein the life factor is related to an aspect of a specific human being, the aspect selected from the group consisting of a biometric pattern (column 4 lines 38 to 59; column 5 line 7 to 23; column 6 line 45 to 51).

Applicant replies that Claim 3 is cancelled without prejudice and in the interest of an expeditious prosecution.

In reference to Claim 4, examiner states that Yap et al. in view of Hopkins disclose the system and the secure document of claim 1, Yap et al. disclose wherein the integrated circuit is an RFID (column 5 line 64 to column 6 line 16; column 7 lines 36 to 43; see Figures 1 to 7).

Applicant replies that Claim 4 as currently amended is dependent from the allowable Claims 8 and 1 and is therefore allowable.

In reference to Claim 5, examiner states that Yap et a;. in view of Hopkins disclose the secure document of claim 1, Hopkins discloses wherein the 2nd digital code (aB0 (i.e. a secret value) is secret key, and the key is configured for use in an encryption method (column 2 lines 62 to 65).

Applicant replies that Claim 5 is cancelled without prejudice and in the interest of an expeditious prosecution.

In reference to Claim 6, examiner states that Yap et al, in view of Hopkins disclose the secure document, to the extent as claimed with respect to claim 1 above, and Yap et al. disclose further that whereby certification for authentication of the secure document (10) is based at least partly on the first digital code (i.e. secure identification data) stored within the integrated circuit (14) (column 15 lines 53 to 65).

Applicant replies that Claim 6 is cancelled without prejudice and in the interest of an expeditious prosecution.

Examiiner rejects Claims 7 and 10-26 under 35 U.S.C. 103(a) as being unpatentable over Yap et al. (US#6,111,506) in view of Hopkins (US# 5,757, 918) and in further view of Moriguchi et al. (US# 6,587,756).

In reference to Claim 7, examiner states that Yap et al. in view of Hopkins disclose the secure documentation system, to the extent as claimed with respect to claim 1 above, and Yap et al. further disclose an information technology system (60) (i.e. a security system) for periodically associating an identity of a specific human being to the document (10) via at least one bio-metric measurement (72) (i.e. biometric data input device); and a security system (64) (i.e. a computer) for recording a personal identification number, or "PIN", on the document (10) (column 14 line 54 to column 16 line 11; see Figures 1 to 7).

Examiner further states that, however, Yap et al. in view of Hopkins did not explicitly disclose means for automatically updating information stored in the electronic memories of the related documents in accordance with information stored in the first memory element.

Examiner further states that, in the same field of endeavor of communication system, Moriguchi et al, teach that means for automatically updating information stored in the electronic memories (12) (i.e. storage means) of the related documents (12) (i.e. a device) in accordance with information stored in the first memory element (111) (i.e. storage medium of a communication terminal) (column 4 lines 12 to 19; column 9 lines 46 to 65; see Figure 22) in order to improve operationality of the user and easier for the user to carry out.

Examiner further states that, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize setting information onto the first device can be stored automatically in the storage medium of the second device taught by Moriguchi et al. in a secure documentation system of Yap et al. in view of Hopkins because automatically update information stored in the memories of a plurality of documents would increase operationality of the system.

Applicant replies that Claim 7 as currently amended is dependent from the allowable Claim 8 and is therefore allowable.

In reference to Claim 10, examiner states that Yap et al. in view of Hopkins disclose the secure documentation system, to the extent as claimed with respect to claim 1 above, hover, Yap et al. in view of Hopkins did not explicitly disclose means for automatically updating information stored in the electronic memories of the related documents in accordance with the information stored in the first memory element.

Examiner further states that, in the same field of endeavor of communication system, Moriguchi et al. teach that means for automatically updating information stored in the electronic memories (12) (i.e. storage means) of the related documents (12) (i.e. a device) in accordance with information stored in the first memory element (111) (i.e. storage medium of a communication terminal) (column 4 lines 12 to 19; column 9 lines 46 to 65; see Figure 22) in order to improve operationality of the user and easier for the user to carry out.

Examiner further states that, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize setting information onto the first device can be stored aoutomatically in the storage medium of the second device taught by Moriguchi et al. in a secure documentation system of Yap et al. in view of Hopkins because automatically update information stored in the memories of a plurality of documents would increase operationality of the system.

Applicant replies that Claim 10 as currently amended is dependent from the allowable Claim 8 and is therefore allowable.

In reference to Claims 11-13, examiner states that Yap et al. in view of Hopkins and in further view of Moriguchi et al. disclose the system of claim 10, the claims 11-13 same as claims 2-4 already addressed. Examiner therefore rejects claims 11-13 for the same obvious reasons given with respect to claims 2-4.

Applicant replies that Claims 11 and 12 as currently amended are dependent from the allowable Claims 8 and 10 and are therefore allowable. Applicant further replies that Claims 13 as currently amended is dependent from the allowable Claims 8, 10 and 12 and is therefore allowable.

In reference to Claims 14-15, 17-19 and 21-26, examiner states that Yap et al. disclose a system (60) (i.e. a security system) for life events record authentication, the system (60) comprising:

a document (10) having a flexible substrate (12) and an integrated circuit (15) , the flexible substrate (15) having a surface, the surface visibly presenting information (column 4 line 2 to 24; column 12 line 28 to 42; see Figures 1 to 5);

the integrated circuit (15) coupled with the substrate (12), the integrated circuit (15) including: a durable memory (i.e. embedded in microprocessor 14) containing a first information (i.e. secure identification data), wherein the first information is related to information selected from the group consisting of (i.e. biometric data) (column 4 lines 38 to 59; column 5 lines 45 to column 6 line 33; column 12 lines 43 to 58; see Figures 1 and 7).

Examiner further states that, however, Yap et al. did not explicitly disclose wherein an authentication of the document is based at least partly on the at least one secret key; wherein access to the first information requires the use of the secret key; and wherein the secret key may be communicated by private means from a first agency to a second agency and the secret key may be used to delegate authority from the first authority to the second authority and means for automatically updating information stored in the electronic memories of the related documents in accordance with information stored in the first memory element.

Examiner further states that in the same field of endeavor of a portable security device, Hopkins discloses an authentication of the document (12) (i.e. a smart card) is base at least partly on the at least one secret key (aB) (i.e. a secret value) (column 2 line 45 to 67; see Figures 1 and 2); wherein access to the first information (U) (i.e. public information) requires the use of the secret key (U) column 3 lines 1 to 60; see Figure 1); and wherein the secret key (U) may be

communicated by private means (26) from a first agency (20) (i.e. a card issuer site) to a second agency (22) (i.e. a terminal) and the secret key (U) may be used to delegate authority from the first authority (20) to secure verification and authentication system.

Examiner further states that one or ordinary skill in the art recognizes the need for the terminal to verify the smart card by a secret value taught by Hopkins in a security identification document of Yap et al. because Yap et al. suggest it is desired to provide that the memory in the document with a RFID integrated circuit can be used to store a plurality of security identification data of a user (column 5 line 45 to 68; column 6 line 45 to 67) and Hopkins teaches that a terminal verifies the smart card for counterfeit and that the user is authorized by the value of secret key (column 5 line 1 to column 6 line 65; see Figures 1 to 3) in order to improve security at the terminal for verifying a smart card and the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to have a/the terminal to verify the smart card by a secret value taught by Hopkins in a security identification document of Yap et al. with the motivation for doing so would have been to provide a secure communicating in each of the cards in a programmable security identification document.

Examiner further states that in the same field of endeavor of communication system, Moriguchi et al. teach that means for automatically updating information stored in the electronic memories (121) (i.e. storage means) of the related documents (12) (i.e. a devise) in accordance with information stored in the first memory element (111) (i.e. storage medium of a communication terminal) (column 4 lines 12 to 19; column 9 lines 46 to 65; see Figure 22) in order to improve operationality of the user and easier for the user to carry out.

Examiner further states that at the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize setting information onto the first device can be

stored automatically in the storage medium of the second device taught by Moriguchi et al. in a secure documentation system of Yap et al. in view of Hopkins because automatically update information stored in the memories of a plurality of documents would increase operationality of the system.

Applicant replies that Claims 21, 22 and 23 are cancelled without prejudice and in the interest of an expeditious prosecution. Applicant replies that Claims 14, 18, 24-26 as currently amended are dependent from the allowable Claim 8 and is therefore allowable. Applicant further replies that Claims 15 and 17 are dependent from Claims 8 and 14 and are therefore allowable. Applicant further replies that Claim 19 is dependent from Claims 8 and 18 and is therefore allowable.

In reference to Claims 16 and 20, Examiner states that Yap et al. in view of Hopkins and Moriguchi et al. disclose the system and the secure document of claims 14 and 18, Yap et al. disclose wherein the integrated circuit is an RFID (column 5 line 64 to column 6 line 16; column 7 lines 36 to 43; see Figures 1 to 7).

Applicant replies that Claim 16 as currently amended is dependent from the allowable Claims 8 and Claim 14, and is therefore allowable.
Applicant further replies that Claim 20 is dependent from Claims 8 and 18 and is therefore allowable.

Allowable Subject Matter

Examiner states that Claims 8-9 would be allowable if rewritten to overcome the objection, set forth in this Office action and to include all of the limitation of the base claim and any intervening claims.

In reference to claim 8, examiner states the following as reasons for the indication of allowable subject matter: the prior art fail to suggest wherein the secondary digital code is associated with the primary document, and wherein the primary document and secondary digital code are permanently associable with each other, and whereby a change in information stored in the memory related to the primary or secondary document may direct the communications network to automatically update information stored within electronic memories of a plurality of documents that are associated by the electronic communications network to wither the primary or the secondary document.

Examiner finally states that any comments considered necessary by applicant must be submitted no later that the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labelled "Comments on Statement of Reasons for Allowance."

Applicant respectfully submits that that the Claims as currently submitted are allowable.

If any matters can be resolved by telephone, Applicant requests that the Patent and Trademark Office call the Applicant at the telephone number listed below.

Respectfully submitted,

By: _____
Patrick Reilly
Reg. No. 37,427

Patrick Reilly
Patent Attorney
Box 7218
Santa Cruz, CA 95061-7218
(831) 332 7127